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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
0870810, 127	03/15/98	HLINKOVSKY	A 5053, 200-US

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EXAMINER

WEATHERSPOON, J

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

12/03/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/080,127

Applicant(s)
Blinkovsky et al

Examiner
John K. Weatherspoon

Group Art Unit
1645



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-45 is/are pending in the application.

Of the above, claim(s) 23-26 and 28-43 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22, 27, 44, and 45 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-45 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

1. The preliminary amendment dated May 15, 1998 has been entered into the record.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. The drawings are objected to by the draftsman under 37 C.F.R. 1.84 or 1.152. See PTO-948 for details. Correction of the noted defects can be deferred until the application is allowed by the examiner.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, 27 and 44-45, drawn to polypeptide, compositions comprising said polypeptide, and a method for producing said polypeptide comprising recovering said polypeptide from a supernatant, classified, for example, in class 530, subclass 350.
 - II. Claims 23-26 and 28-29, drawn to nucleic acid sequence and construct, an expression vector, host cell, and methods for producing a polypeptide comprising cultivating said host cell or cultivating a homologously recombinant cell having incorporated therein a new transcription unit, classified, for example, in classes 536 and 435, subclasses 23.1 and 69.1, respectively.
 - III. Claims 30-31, drawn to a cell mutant and method for producing said cell mutant, classified, for example, in class 435, subclass 471.

Art Unit: 1645

IV. Claim 32, drawn to a method for producing a heterologous polypeptide, classified, for example, in class 435, subclass 70.1.

V. Claims 33-39, drawn to a protein hydrolysate and methods of producing said protein hydrolysate from a proteinaceous substrate, classified, for example, in class 435, subclass 68.1.

VI. Claims 40-43, drawn to a protein hydrolysate enriched in free glutamic acid and/or peptide bound glutamic acid residues, and methods for obtaining said protein hydrolysate, classified, for example, in class 530, subclass 402.

4. The claims of Groups I-VI are drawn to distinct methods which differ in the method objectives, steps and parameters and in the reagents used. Group I contains claims drawn to a method for producing a polypeptide comprising recovering said polypeptide from a supernatant. Group II contains claims drawn to methods for producing a polypeptide comprising cultivating a host cell or cultivating a homologously recombinant cell having incorporated therein a new transcription unit. Group III contains claims drawn to a method for producing a cell mutant. Group IV contains a claim drawn to a method for producing a heterologous polypeptide. Group V contains claims drawn to methods of producing a protein hydrolysate from a proteinaceous substrate. Group VI contains claims drawn to methods for obtaining a protein hydrolysate enriched in free glutamic acid and/or peptide bound glutamic acid residues. These methods are clearly distinct.

5. The claims of Groups I-III and V-VI are drawn to structurally and functionally distinct products. Group I contains claims drawn to polypeptide and compositions comprising said

Art Unit: 1645

polypeptide. Group II contains claims drawn to nucleic acid sequence and construct, an expression vector and host cell. Group III contains claims drawn to a cell mutant. Group V contains claims drawn to a protein hydrolysate. Group VI contains claims drawn to a protein hydrolysate enriched in free glutamic acid and/or peptide bound glutamic acid residues. These products are clearly distinct.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and/or recognized divergent subject matter and because the searches required for examination of the groups identified above are not coextensive, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Robert Starnes on December 3, 1998, an election was made with traverse to prosecute the invention of Group I, claims 1-22, 27 and 44-45. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-26 and 28-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1645

Claim Objections

9. Claim 9 is objected to because of the following informalities: the phrase “aa *Aspergillus* strain” contains the objectionable term “aa”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. Claims 1 and dependent claims thereof, i.e. claims 2-22 and 27 and 44-45, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “medium stringency” in claims 1 and dependent claims thereof, i.e. claims 2-22 and 27 and 44-45, and claims 11-12, and the term “high stringency” in claims 15-16, are relative terms which render the claims indefinite. The terms “medium stringency” and “high stringency” in the specification (page 11) do not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

11. Claim 1 and dependent claims thereof, i.e. claims 2-22 and 27 and 44-45, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms “50% identity”, “60% identity”, “70% identity”, “80% identity” and “90% identity” in claim 1 and said dependent claims thereof are relative terms which renders the claims indefinite. Said terms in the specification (page 4) do not provide a standard for ascertaining the

Art Unit: 1645

requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification (page 4) refers to the use of “the Clustal method with an “identity table” to measure sequence identity. However, the specification fails to clearly point out the parameters or properties of said “identity table”. Absent definite and clear parameters or description of said Clustal method identity table to determine percent identity of two sequences, use of said identity table could result in inconsistent assessment of sequence identity absent clear recitation of the parameters, and the metes and bounds of the sequences as instantly claimed can not be ascertained.

12. Claims 19 and dependent claims thereof, i.e. claims 20-21, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “relative to initial activity” is a relative term which renders the claims indefinite. The specification does not provide a standard for ascertaining the requisite degree of the metes and bounds of said term, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

13. Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “flavor-improving composition” is a relative term which renders the claims indefinite. The specification does not provide a standard for ascertaining the requisite degree of

Art Unit: 1645

the metes and bounds of said term, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 1, 7, 11-18 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Holm et al (U.S. Patent No. 5,821,104, filed March 19, 1997). Holm et al disclose an isolated polypeptide having aminopeptidase activity wherein said polypeptide is encoded by a nucleic acid sequence which hybridizes with the nucleic acid sequence or a subsequence of SEQ ID NO:1 or its complementary strand (as stated in instant claim 1) (see entire reference) and wherein said polypeptide is obtained from an *Aspergillus oryzae* strain (see entire reference, for example column 3). Holm et al also disclose a polypeptide comprising a fragment of the sequence of instant SEQ ID NO:2 and a method for producing said polypeptide comprising recovering said polypeptide from said *Aspergillus* strain (see entire reference).

Art Unit: 1645

16. Claims 1, 7, 11-18, 27 and 44-45 are rejected under 35 U.S.C. 102(a) as being anticipated by Kauppinen et al (WO 96/28542, published September 19, 1996; reference cited by applicant in PTO-1449). Kauppinen et al disclose an isolated polypeptide having aminopeptidase activity wherein said polypeptide is encoded by a nucleic acid sequence which hybridizes with the nucleic acid sequence or a subsequence of SEQ ID NO:1 or its complementary strand (as stated in instant claim 1) (see entire reference) and wherein said polypeptide is obtained from an *Aspergillus oryzae* strain (see entire reference, for example pages 4 and 6). Kauppinen et al also disclose a polypeptide comprising a fragment of the sequence of instant SEQ ID NO:2, a method for producing said polypeptide comprising recovering said polypeptide from said *Aspergillus* strain (see entire reference) and compositions comprising said aminopeptidase as recited in the instant claims 44-45 (see entire reference).

Status of Claims

17. No claim is allowed.

18. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1645 is (703) 308-4242.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Weatherspoon, Ph.D. whose telephone number is (703) 305-0557.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached at (703) 308-3995.

John Weatherspoon, Ph.D.

December 4, 1998



Anthony Caputa, Ph.D.

Supervisory Primary Examiner

Group 1645